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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/562,194	12/23/2005	Jurgen Stetter	710270-030	4116

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EXAMINER

LEE, GILBERT Y

ART UNIT	PAPER NUMBER
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3673

DATE MAILED: 05/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/562,194

Applicant(s)

STETTER ET AL.

Examiner

Gilbert Y. Lee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-22 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 12-22 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 December 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Information Disclosure Statement

1. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Drawings

The drawings are objected to under 37 CFR 1.83(b) because they are incomplete. 37 CFR 1.83(b) reads as follows:

When the invention consists of an improvement on an old machine the drawing must when possible exhibit, in one or more views, the improved portion itself, disconnected from the old structure, and also in another view, so much only of the old structure as will suffice to show the connection of the invention therewith.

2. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes

made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

It is unclear to the examiner as to how Fig. 1 correlates to Figs. 2-10. It is also unclear as to how Fig. 3 can be showing both the block (3) and the chain housing (4) in the same figure, when Fig. 3 is a partial view of Fig. 2, which is a gasket. It is also unclear to the examiner as to what the applicant is trying to claim as the functional position and the distance position in Figs. 4-6. For the purposes of this examination, the examiner is interpreting the functional positions to be the layers labeled as 12 and 13; and the distance position to be the middle layer 11.

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the gasket element turned towards recess in claim 21 and the at least one hollow in claim 21 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate

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prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

4. The disclosure is objected to because of the following informalities: in para. [00024], line 2 "a cylinder block 2," should be removed and in para. [00027], line 10 "hollow" should be changed to --recess--.

Appropriate correction is required.

Claim Objections

5. Claim 18 is objected to because of the following informalities: in line 2 "that is" should be changed to --that it--. Appropriate correction is required.

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6. Claim 21 is objected to because of the following informalities: in line 1 "te" should be changed to --the--. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 12-22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It is unclear to the examiner as to how the gasket relates to a "T-Junction".

Fig. 1 clearly depicts a "T-Junction" but it is unclear to the examiner as to how the gasket of Fig. 2 correlates to the "T-Junction" of Fig. 1.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 12-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors (specifically claims 1 and 21).

Claim 12 recites the limitation "at least one of these" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 12 recites the limitation "T-position" in line 5. There is insufficient antecedent basis for this limitation in the claim.

Regarding claims 17-22, the claims are dependent from previously cancelled claims.

Claim 19 recites the limitation "without contact to the boundaries"; whereas claim 18 recites the limitation "partially supports itself on boundary regions". Because claim 19 depends from claim 18, it is unclear to examiner whether the applicant is claiming the gasket element to be contacting or non-contacting with the boundaries of the recessed region.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. As best understood, claims 12-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Habuta et al. (US Patent No. 5,895,056).

Regarding claim 12, the Habuta et al. reference discloses a cylinder head gasket (Fig. 1) for an internal combustion engine, insertable for the sealing of components which has at least one of these, with at least one T-junction (e.g. 30) formed region, having at least one functional position (e.g. 15) and at least one distance position (e.g. 6) as well as at least one additional gasket element (25), which is provided in the region of the T-junction wherein the distance position is provided at least in the region of the T-junction with at least one recessed region (e.g. 13) serving for the intake of the additional gasket element.

Regarding claim 13, the Habuta et al. reference discloses the gasket element protruding over the recessed region in the direction of at least one of the sealed components (Fig. 3).

Regarding claim 14, the Habuta et al. reference discloses the distance position in the region of the gasket element is associated with at least one functional position, which is provided on the gasket element side with a recess (e.g. recess between elements 41 and 11).

Regarding claim 15, the Habuta et al. reference discloses the recessed region having a larger cross-section than the recess (Fig. 3).

Regarding claim 16, the Habuta et al. reference discloses at least a part of the recess being provided above the recessed region (Fig. 3) and is essentially parallel thereto (Fig. 3).

Regarding claim 17, the Habuta et al. reference discloses the recess region being generally oval in form (Fig. 2).

Regarding claim 20, the Habuta et al. reference discloses the gasket element being arranged in such a way in the recessed region that that it is adjacent to partial regions of the boundary regions of the recessed region and is at least partially outside of the recessed region supporting itself on the distance position protruding above the boundary regions (Fig. 3).

Regarding claim 21, the Habuta et al. reference discloses the region of the gasket element turned towards the recess of the functional position at least one hollow (e.g. are between lead lines 13 and 18 in Fig. 3) is provided to the recess.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Weiss et al. (US Patent No. 5,727,791), Bohringer et al. (US Pub. No. 2004/0212157A1), Li (US Patent No. 6,056,296), Mori et al. (US Pub. No. 2002/0117812A1), Hegmann (US Pub. No. 2001/0045707A1), Fujino et al. (US Patent No. 2001/0024017A1), Fujino et al. (US Patent No. 6,719,300), Furuta et al. (US Patent No. 6,702,297), Hegmann et al. (US Patent No. 6,641,142), Hegmann (US Patent No. 6,631,909), Futura et al. (US Pub. No. 2002/0063394), Hegmann (US Pub. No. 2001/0048201), Hegmann et al. (US Pub. No. 2001/0048200A1), Hegmann (US Patent no. 6,527,277), and Kubouchi et al. (US Patent No. 5,544,901).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gilbert Y. Lee whose telephone number is 571-272-5894. The examiner can normally be reached on 8:00 - 4:30, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patricia L. Engle can be reached on (571)272-6660. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Patricia Engle
SPE
Art Unit 3673

GL
5/23/06



Suzanne Dino Barrett
Primary Examiner